

REMARKS

Claims 1,2, 17,20,22-25 and 34-38 are pending in the case.

All claims stand finally rejected under 35 USC § 112.

Claim 1 has been amended to more clearly define Applicants' invention.

No new matter has been added.

It is respectfully submitted that entry of the present response and amendment is proper under 37 C.F.R. 1.116 as it:

- (i) places the application in condition for allowance;
- (ii) does not raise any new issues requiring further search of consideration; and
- (iii) places the application in better form for appeal (if necessary).

Claim Rejections – 35 USC § 112

Claims 1,2 17,20, 22-25 and 34-38 are rejected under 35 USC § 112, first paragraph for lack of written description.

The Examiner has found Applicants' previous arguments of record not persuasive because "[T]he invention as claimed reads upon a nucleotide sequence obtained from any organism that is essential for its replication." The examiner supports this statement with the observation that the term "replication protein" fails to distinguish the claimed nucleotide from any other sequence found in a microorganism which encodes a protein essential for the microorganism's replication. Applying the guidelines for the Written Description Requirement, the examiner further notes that SEQ ID NO:2 is defined only by the term "replication protein" which conveys no distinguishing information about the identity of the claims DNA sequence such as structural or physical characteristics.

Applicant's respectfully traverse.

It may be useful to here to note a possible misunderstanding as to the nature and scope of a replication protein has enabled by the present application. A "replication protein" is defined on page 19, beginning on line 4 and variously throughout the specification and refers to a protein that controls the replication of a plasmid residing in a host cell. Thus, the term "replication protein" is not so broad as to encompass any nucleotide sequence obtained from any organism that is essential for its replication, as the examiner suggests. For the sake of clarity Claim 1 has been amended to emphasize this point.

Given the limited scope of the term "replication protein" as defined and used in the specification, Applicants submit that the term, in combination with the stated hybridization conditions, does indeed provide structural and physical characteristics that will provide notice to the person of skill in the art that the inventor was in possession of the invention as claimed. For example, a replication protein possesses the identifying characteristic of enabling a plasmid to replicate autonomously in a specific host cell. This is a very specific function and defines a finite class of proteins. Additionally the

hybridization conditions are stringent, requiring a high degree of base identity to SEQ ID NO:2, which in and of itself provides a structural and physical characteristics identifying the claimed sequences.

Applicants submit that the claims meet all the requirements of 35 USC § 112 first paragraph and respectfully request removal of all rejections and reconsideration of the claims as amended.

Respectfully submitted,



S. NEIL FELTHAM
ATTORNEY FOR APPLICANTS
Registration No.: 36,506
Telephone: (302) 992-6460
Facsimile: (302) 992-5374

Dated: December 30, 2003